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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,819	01/22/2001	Robert M. Zeidman		9823

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MACPHERSON KWOK CHEN & HEID LLP
2033 GATEWAY PLACE
SUITE 400
SAN JOSE, CA 95110

EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/767,819

Applicant(s)

ZEIDMAN, ROBERT M.

Examiner

Scott Beliveau

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Miscellaneous

1. Please note that the examiner of record for this application has changed.

Continued Examination

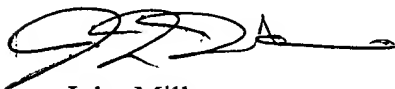
2. In view of the Appeal Brief filed on 23 August 2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

A handwritten signature in black ink, appearing to read 'J. Miller', with a long horizontal flourish extending to the right.

John Miller.

Response to Arguments

Art Unit: 2623

3. The OFFICIAL NOTICE originally presented in the Non-Final Rejection (mailed 12 August 2004) and repeated throughout prosecution that it notoriously well know in the art to use a web page so as to facilitate the organization of URLs has not been traversed and is accordingly taken as an admission of the fact noted.
4. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Regarding applicant's arguments that Matheny by disclosing a broadcast with commercial interruptions teaches away from a broadcast without commercial interruptions, the examiner respectfully disagrees. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). In the instant case, Matheny explicitly discloses that its teachings are operable both with commercials and with other types of broadcasts (Col 2, Lines 38-42). The 'interruptions' in Matheny are not 'commercial interruptions' as set forth in the specification. Rather, they are opportunities (ex. surveys) being provided to reward viewership as opposed to breaking up the program. It is well established in the art that a particular type of broadcast is a broadcast program without commercial interruptions. For example, PBS typically airs programming without commercial interruptions or as evidenced by the art of record over 65 million people in February 1997 tuned in to watch a broadcast of "Schindler's List" that did not contain commercial interruptions and was sponsored by Ford Motor company. Accordingly, the claims are not believed patentable in light of the ability to employ the teachings of Matheny

in association with a particular type of broadcast, namely one that does not contain commercial interruptions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the 1997 Broadcast of "Schindler's List" on NBC in view of Matheny et al. (US Pat No 6,766,524).

In regard to claim 1, the "You Should Know Better, Mr. Spielberg" article provides evidence that it is known in the art of television broadcasting to "allow content to be broadcast without commercial interruption" yet still be sponsored by companies. However, the evidence of the particular species of 'broadcast programming' is silent with respect further providing incentives to viewers to watch.

In an analogous art pertaining to the field of television, Methany et al. discloses a system and method to encourage viewers to pay attention to television programs. The step of "receiving a broadcast with embedded information about the broadcast, said embedded information being provided to allow constructing a viewing record of the broadcast" is met by Figures 2-3. "Reward notice 260 and reward query 275 are conveyed in trigger messages, or "triggers," broadcast to receivers of broadcast video. Such triggers generally instruct receivers to take a specific action to synchronize the content of a Web page with a broadcast

television program. Reward notices and reward queries may be transmitted in the VBI of a broadcast video signal. The text service channels of line 21 of the VBI provide a robust communication medium, albeit at relatively low bandwidth” (Col 4, Lines 28-36). The claimed step of “extracting and displaying content from said broadcast” is met by Figure 2. “Receiver 215 includes a television set 235 connected via a video line 240 to a set-top box 245 similar to set-top box 110 of FIG. 1. Television set 235 and set-top box 245 work together to display Web pages, broadcast television, or both. Web pages are typically downloaded over the Internet 230, but may also be received from video signal 210 or retrieved from a local memory, such as a disk drive 250 in set-top box 245. Set-top box 245 stores Web pages locally in each case” (Col 2, Lines 48-55). “FIG. 2 illustrates a communication system 200 that enables television sponsors to reward viewers for paying attention to broadcast television commercials **and other types of broadcast programs**” (Col 2, Lines 39-42). The claimed step of “extracting said embedded information from said broadcast” is met by Figure 2. As detailed in Col 4, Lines 28-36, the embedded information is extracted from the VBI. The claimed steps of “storing said embedded information” and “at a predetermined time, sending said stored embedded information and viewer information to a remote computer to allow said viewing record” are met by Figures 2 and 4. “Returning to the example of FIG. 2, if a viewer answers question 269, then set-top box 245 notes the identity of the program in which the question appeared, the time the question was posed, a value expressing how much of the program was viewed, and the viewer's answer to the query. Set-top box 245 then stores this information in a local log file 271 on disk drive 250. In other embodiments, set-top box 245 collects different types of information to identify whether

viewers respond to selected programs when prompted. The contents of log file 271 are eventually pushed to remote information store 220. In one embodiment, set-top box 245 periodically establishes network connection 225 to accomplish this push” (Col 3, Lines 46-60). The claimed step of “providing specific incentives to the view based on said embedded information and said viewer information sent” is met by Figure 2-4. “The message that includes unique identifier 275 notifies information store 220 that the viewer associated with receiver 215 has answered a query, and may therefore be entitled to a reward. Information store 220 determines, based on the information identifying the program, whether the viewer provided the correct answer. If so, then information store 220 allocates the appropriate reward to the viewer” (Col 4, Lines 14-21). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teachings of Methany et al. with other types of programming including “broadcasts without commercial interruption” for the purpose of providing a means to encourage viewers to pay attention to TV programs.

In regard to claim 2, the ‘You Should Know Better, Mr. Spielberg’ article provides evidence that it is known in the art of television broadcasting to “allow content to be broadcast without commercial interruption” yet still be sponsored by companies. However, the evidence of the particular species of ‘broadcast programming’ is silent with respect further providing incentives to viewers to watch.

In an analogous art pertaining to the field of television, Methany et al. discloses a system and method to encourage viewers to pay attention to television programs. The claimed step of “receiving a broadcast with information about the broadcast embedded into the broadcast

at regular time periods, said information including timestamp each identifying the time slice during which the broadcast is received” is met by Figures 2-3. “Reward notice 260 and reward query 275 are conveyed in trigger messages, or “triggers,” broadcast to receivers of broadcast video. Such triggers generally instruct receivers to take a specific action to synchronize the content of a Web page with a broadcast television program. Reward notices and reward queries may be transmitted in the VBI of a broadcast video signal. The text service channels of line 21 of the VBI provide a robust communication medium, albeit at relatively low bandwidth” (Col 4, Lines 28-36). “[E]ach trigger includes a time stamp. Thus, the time attribute of the selected reward notice 260 can be used to determine the point at which the viewer tuned into the commercial” (Col 7, Lines 28-30). The claimed step of “extracting and displaying content from said broadcast” is met by Figure 2. “Receiver 215 includes a television set 235 connected via a video line 240 to a set-top box 245 similar to set-top box 110 of FIG. 1. Television set 235 and set-top box 245 work together to display Web pages, broadcast television, or both. Web pages are typically downloaded over the Internet 230, but may also be received from video signal 210 or retrieved from a local memory, such as a disk drive 250 in set-top box 245. Set-top box 245 stores Web pages locally in each case” (Col 2, Lines 48-55). “FIG. 2 illustrates a communication system 200 that enables television sponsors to reward viewers for paying attention to broadcast television commercials **and other types of broadcast programs**” (Col 2, Lines 39-42). The claimed step of “extracting said embedded information from said broadcast” is met by Figure 2. As detailed in Col 4, Lines 28-36, the embedded information is extracted from the VBI. The claimed step of “incrementing counters for counting time slices during which broadcasting is

received” is met by Figure 2-4. “[E]ach trigger includes a time stamp. Thus, the time attribute of the selected reward notice 260 can be used to determine the point at which the viewer tuned into the commercial” (Col 7, Lines 28-30). “Returning to the example of FIG. 2, if a viewer answers question 269, then set-top box 245 notes the identity of the program in which the question appeared, the time the question was posed, a value expressing how much of the program was viewed, and the viewer's answer to the query” (Col 3, Lines 46-50). The claimed steps of “storing said embedded information” and “sending said embedded information and viewer information to a remote computer” are met by Figures 2 and 4. “Returning to the example of FIG. 2, if a viewer answers question 269, then set-top box 245 notes the identity of the program in which the question appeared, the time the question was posed, a value expressing how much of the program was viewed, and the viewer's answer to the query. Set-top box 245 then stores this information in a local log file 271 on disk drive 250. In other embodiments, set-top box 245 collects different types of information to identify whether viewers respond to selected programs when prompted. The contents of log file 271 are eventually pushed to remote information store 220. In one embodiment, set-top box 245 periodically establishes network connection 225 to accomplish this push” (Col 3, Lines 46-60). The claimed step of “receiving specific incentives based on said embedded information and said viewer information sent” is met by Figure 2-4. “The message that includes unique identifier 275 notifies information store 220 that the viewer associated with receiver 215 has answered a query, and may therefore be entitled to a reward. Information store 220 determines, based on the information identifying the program, whether the viewer provided the correct answer. If so, then information store 220 allocates the appropriate reward to the

viewer” (Col 4, Lines 14-21). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teachings of Methany et al. with other types of programming including “broadcasts without commercial interruption” for the purpose of providing a means to encourage viewers to pay attention to TV programs.

In regard to claim 3, the ‘You Should Know Better, Mr. Spielberg’ article provides evidence that it is known in the art of television broadcasting to “allow content to be broadcast without commercial interruption” yet still be sponsored by companies. However, the evidence of the particular species of ‘broadcast programming’ is silent with respect further providing incentives to viewers to watch.

In an analogous art pertaining to the field of television, Methany et al. discloses a system and method to encourage viewers to pay attention to television programs. The claimed steps of “embedding information along with the broadcast content, said embedded information including information that allows a viewing time of said broadcast content to be determined” and “broadcasting said content with said embedded information to a remote viewer of the content” are met by Figure 3. “Reward notice 260 and reward query 275 are conveyed in trigger messages, or “triggers,” broadcast to receivers of broadcast video. Such triggers generally instruct receivers to take a specific action to synchronize the content of a Web page with a broadcast television program. Reward notices and reward queries may be transmitted in the VBI of a broadcast video signal. The text service channels of line 21 of the VBI provide a robust communication medium, albeit at relatively low bandwidth” (Col 4, Lines 28-36). “Receiver 215 includes a television set 235 connected via a video line 240 to a set-

top box 245 similar to set-top box 110 of FIG. 1. Television set 235 and set-top box 245 work together to display Web pages, broadcast television, or both. Web pages are typically downloaded over the Internet 230, but may also be received from video signal 210 or retrieved from a local memory, such as a disk drive 250 in set-top box 245. Set-top box 245 stores Web pages locally in each case” (Col 2, Lines 48-55). “FIG. 2 illustrates a communication system 200 that enables television sponsors to reward viewers for paying attention to broadcast television commercials **and other types of broadcast programs**” (Col 2, Lines 39-42). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teachings of Methany et al. with other types of programming including “content without commercial interruption” for the purpose of providing a means to encourage viewers to pay attention to TV programs.

In regard to claim 4, the claimed step of “obtaining stored embedded information from said viewer so as to determine said viewing time” is met by Figures 2-4. “Returning to the example of FIG. 2, if a viewer answers question 269, then set-top box 245 notes the identity of the program in which the question appeared, the time the question was posed, a value expressing how much of the program was viewed, and the viewer's answer to the query. Set-top box 245 then stores this information in a local log file 271 on disk drive 250. In other embodiments, set-top box 245 collects different types of information to identify whether viewers respond to selected programs when prompted. The contents of log file 271 are eventually pushed to remote information store 220. In one embodiment, set-top box 245 periodically establishes network connection 225 to accomplish this push” (Col 3, Lines 46-60). The claimed step of “sending specific incentives to said viewer based on said viewing

time” is met by Figures 2-4. “The message that includes unique identifier 275 notifies information store 220 that the viewer associated with receiver 215 has answered a query, and may therefore be entitled to a reward. Information store 220 determines, based on the information identifying the program, whether the viewer provided the correct answer. If so, then information store 220 allocates the appropriate reward to the viewer” (Col 4, Lines 14-21).

Claims 5-6 and 7-8 are met by that discussed above for claims 2-4.

In regard to claims 9-10, the recited limitations are met by that discussed above for claims 2-4 except the reference fails to explicitly disclose creating a Web page containing links to all sponsor incentive websites and to specific incentives and sending said Web page back to said viewer; however, the applicant’s admission of fact provides evidence that it notoriously well know in the art to use a web page so as to facilitate the organization of URLs. Consequently, it would have been obvious to one of ordinary skill in the art to implement Matheny with the use a web page so as to facilitate the organization of URLs.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- The ‘Schindler’s List on TV – reaction against’ article provides evidence regarding the particular broadcast of ‘Schindler’s List’ without commercial interruption being viewed by 65 million people.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SEB

December 7, 2006

Scott Beliveau
Primary Examiner
Art Unit 2623